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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,773	07/22/2003	Kenneth P. Howell JR.	502334	6778
23626	7590	04/13/2004		
LEYDIG VOIT & MAYER, LTD 6815 WEAVER ROAD ROCKFORD, IL 61114-8018				
EXAMINER RICHARDSON, JOHN A				
ART UNIT			PAPER NUMBER	
3641				

DATE MAILED: 04/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/624,773

Applicant(s)

HOWELL, KENNETH P.

Examiner

John Richardson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on July 22 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☐ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 19 and 20 is/are allowed.
- 6) ☒ Claim(s) 1-14, 16 and 17 is/are rejected.
- 7) ☒ Claim(s) 15 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11-12-2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Non Final Rejection*

1). The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2). Claims 1 to 14, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Howell, Jr (U.S. 6,029,385) in view of Rankine (GB 2329456).

The applicant's claims are for a firearm apparatus per se with intended use for smokeless gunpowder. It is the examiner's position that a firearm apparatus arranged for powder with cap-and-ball caseless ammunition is inherently capable of functioning and performing as cited in the claims.

The primary reference discloses a firearm structure suitable for use with cap-and-ball caseless ammunition comprising a frame (item 12), a barrel (item 16), a trigger (item 20), a hammer (item 18), a cylinder body (item 14) comprising a muzzle end and a breach end, and having a plurality of chambers (items 36) wherein each of the said chambers is arranged with an internal diameter profile accommodating a projectile (item 26) at the muzzle end and an internal diameter profile accommodating primer portion at the breach end, and a removable cylinder cap / plate (item 34) positioned at the breach

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end wherein the said cap / plate incorporates a plurality of linearly translatable firing pins (items 38) as shown in Figures 4, 5, relating to claim 4, the primary reference discloses a cylinder cap / plate locking pin (item 40), relating to claim 5, the said firing pins (items 38) are held captive by items 60, relating to claim 6, the said cylinder cap / plate discloses ratchets (items 52), relating to claims 7, 14, the said cylinder cap / plate is axially translatable relative to the said cylinder body as disclosed in Figure 5, relating to claim 8, the said projectile portion and the said primer portion are axially offset to each other in each of the said chambers as disclosed in for example, Figure 5, relating to claim 10, the primary reference discloses a plate between the said cylinder cap / plate (item 34) and the cylinder body (item 14) as shown in Figure 1, relating to claims 13, 16, the primary reference discloses the said plurality of firing pins (items 38) radially positioned within the said cylinder cap / plate (item 34) and axially aligned with said hammer (item 18) as shown in Figure 2.

The primary reference discloses the claimed apparatus except for the particular details of a propellant portion of the Howell, Jr firing chambers as recited in the claims. The secondary reference, Rankine, discloses that it is well known in the smokeless powder art to provide cylinder details as cited in the applicant's aforementioned claims. It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated caseless ammunition for use in the Howell, Jr, cylinder firing chamber details (items 36) as disclosed by Rankine (see Figure 2) with chamber configuration with a shoulder, a propellant portion, and projectile, propellant and primer portions with cylinder diameter ratios as cited by the applicant, in order to use powder cap-and-ball

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ammunition caseless, and specifically recognizing that the Howell, Jr reference discloses the use of such a construction for "cap and ball" powder revolvers (see Howell, Jr, Column 1, lines 50+).

As to limitations which are considered to be inherent in a reference, note the case law In re Ludke, 169 USPQ 563, In re Swinehart, 169 USPQ 226, In re Fitzgerald, 205 USPQ 594, In re Best et al, 195 USPQ 430, and In re Brown, 173 USPQ 685,688.

It is noted that a claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from prior art apparatus" if the prior art teaches all the structural limitations of the claim. In re Masham, 2 USPQ2d 1647.

Claims directed to apparatus must be distinguished from prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device *is*, not what a device *does*. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP§ 2115, a recitation in a claim to the material or article worked upon, does not serve to limit an apparatus claim.

3). Claims 15,18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

4). Claims 19, 20 are allowed.

5). The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


6). Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Richardson whose telephone number is (703) 305 0764. The examiner can normally be reached on Monday to Thursday from 7.00 AM to 4.30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Carone, can be reached on (703) 306 4198. The fax phone number for the organization where this application or proceeding is assigned is (703) 305 7687.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308 1113.

John Richardson, PE,

April 06 2004.

  
FOR MICHAEL CARONE, SPE 3641

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